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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,264	09/27/2004	Thomas Kreye	KREYE T 1 PCT	5311

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EXAMINER

O HERN, BRENT T

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/509,264

Applicant(s)

KREYE, THOMAS

Examiner

Brent T. O'Hern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-34, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7 Nov. 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claims*

1. Claims 19-34 and 36-37 are pending with claim #35 canceled, claims 36-37 new and claims 19-34 drawn to a non-elected invention.

Applicant's election with traverse of Group II (claim 35) in the replies filed on 28 April 2006 and 7 November 2006 is acknowledged. The traversal is on the ground(s) that Applicant believes the groups are directed to unitary invention a search of Group I would also include a search of Group II. This is not found persuasive because as stated in the Office Action dated 23 March 2006 the fastening system of Group II can be made by a materially different process and the product and process claims are classified in different classes.

The requirement is still deemed proper and is therefore made FINAL.

### WITHDRAWN OBJECTIONS

2. The objection to the **Abstract** of record in the Office Action mailed 17 May 2006, page 2, paragraph 2, has been withdrawn due to Applicant's amended Abstract in the Paper filed 7 November 2006.

### WITHDRAWN REJECTIONS

3. The 35 U.S.C. 112, second paragraph rejection of claim 35 of record in the Office Action mailed 17 May 2006, page 3, paragraph 3, has been withdrawn due to Applicant's amendments in the Paper filed 7 November 2006.

4. The 35 U.S.C. 102(b) rejection of claim 35 as being anticipated by Gross (US 5,088,787) of record in the Office Action mailed 17 May 2006, page 4, paragraph 5, has been withdrawn due to Applicant's amendments in the Paper filed 7 November 2006.

#### NEW REJECTIONS

5. Claims 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross (US 5,088,787).

Regarding claim 36, Gross ('787) teaches a clip-on fastening system (*FIG-1*, #15 "*molding*") comprising:

- a) a component having a clip area (*FIG-1*, clip area #26); and,
- b) a fastening element comprising a hardened continuous profile having a hardness of at least approximately 40 Shore D (*col. 3, ll. 8-9*), the fastening element being connected to a substrate (*See FIG-1 wherein adhesive #35 joins element #23 to substrate #12*), the fastening element having a cross-sectional shape corresponding to the clip area (*See FIG-1 wherein the elements clearly fit together.*).

The phrases "**prefabricated, extruded**" in claim 36, I. 3, and "**in a force-fitting manner and pressed against said substrate with a pressure roller while gluing said fastening element to said substrate to form a finished fastening element**" in claim 36, II. 6-8 are **process** limitations in a product claim and hence not given any patentable weight since patentability of a product does not depend on its method of production (*see MPEP § 2173.05(p)*).

The phrase "**wherein said fastening element functions as a base part of the clip-on fastening system and detachably fastens said substrate to said**

**component when said component is clipped onto said finished fastening element**” in claim 36, lines 11-14 is not given any patentable weight since the applicant is introducing **use** limitations into the product claims (see *MPEP* 2173 (q)).

Regarding claim 37, Gross ('787) teaches wherein the component comprises a gasket (*FIG-1, #17, second member of molding, a gasket*).

### **ANSWERS TO APPLICANT'S ARGUMENTS**

6. In response to Applicant's argument (*p. 12, para. 1 to p. 13, para. 3 of Applicant's Paper filed 7 November 2006*) that the structure as described in Gross ('787) differs substantially from the arrangement as recited in claim 36, it is noted that Gross ('787) teaches a clip-on fastening system (*FIG-1, #15 "molding"*) comprising a) a component having a clip area (*FIG-1, clip area #26*); and, b) a fastening element comprising a hardened continuous profile having a hardness of at least approximately 40 Shore D (*col. 3, ll. 8-9*), the fastening element being connected to a substrate (*See FIG-1 wherein adhesive #35 joins element #23 to substrate #12*), the fastening element having a cross-sectional shape corresponding to the clip area (*See FIG-1 wherein the elements clearly fit together.*).

7. In response to Applicant's argument (*p. 14, para. 2 of Applicant's Paper filed 7 November 2006*) that Gross ('787) does not teach canceled claim 35, it is noted that Applicant's argument is mute since claim 35 is canceled.

8. In response to Applicant's argument (*p. 14, para. 2 of Applicant's Paper filed 7 November 2006*) that Gross ('787) does not teach a profile glued directly to the

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substrate as claimed in claim 36, it is noted that Applicant does not claim glued directly, thus Applicant's argument is not germane to any issue at bar.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-2172. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brent T O'Hern  
Examiner  
Art Unit 1772  
November 27, 2006

  
NASSER AHMAD 12/1/06  
PRIMARY EXAMINER